

REMARKS

Claims 1-12, all the claims pending in the application, stand rejected. Claims 1 and 2 are amended.

Claims 1 and 2 have been amended to define the service as “points related” and to specify that the second server is separate and independent of the first server with respect to points related services. Further, claim 1 is amended to recite the limitation “point transferring means directly transfers points stored in the first server to the second server.”

Claim Rejections - 35 U.S.C. § 103

Claims 1 and 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Postrel (6,594,640) in view of Martinez et al (6,119,229). This rejection is traversed for at least the following reasons.

Claim 1

As previously amended, the claim is directed to a network service system for providing a user with first and second services. The user of both services is the same entity. The “services” are specially defined as “comprising activities which allow users to earn points by using the service.” This is a specific and limiting definition of the term “service” and is intended to exclude other types of user activity or communication that does not provide points to a user of the service. The relationship of the service to earning points is important because other limitations in the body of the claim concern the accumulation, consumption and transfer of the points. In order to emphasize this feature, Applicants have expressly defined the services as “points related services.”

As defined in the claim, the network service system includes separate servers and databases for a common user:

Servers - a first server provides a first such point-generating service directly to a user and a second server provides a second point-generating service directly to a user.

Databases – a first database and a second database are connected to the first and second servers, respectively, for storing point information, each in association with the user identifying information. Notably, the first server/database combination is independent of the second

server/database combination. That is, there is no sharing of the information related to points earned at one location with the other location.

Point Offering – in the first server, there is “point offering means” that offers points to the user so that they can be earned when using a service.

Point Consuming - The second server includes “point consuming means” so as to consume the points of the user when the second service is provided to the user.

Point Transferring – There also is a “point transferring means” for updating point information in the second database, based on the point information stored in the first database. The point transferring means directly transfers points stored in the first server to the second server.

This distributed system operates each server autonomously, without centralized control. That is, a user visiting one location having a first server/database can utilize services and have the earned points stored locally. The user visiting a different location having a second server/database can access and use points stored locally in the first server/database, not by accessing a common storage or processing facility, but by accessing the first server/database.

Through this system and with reference to Fig. 1 for a non-limiting example, activity of a user at a second server 16 can (1) consume points of the same user that were earned and stored at a first server 14 (through a mobile unit 24 or the like), and (2) transfer points accumulated by the user at the first server/database 14/18, based on use of services and the updating of point information, to the second server/database 16/20. In this manner, the user at a second server/database can access and use points accumulated at a first server/database and stored locally. Access and transfer is only as needed and requested.

Postrel

In framing the rejection, the Examiner describes Postrel at pages 2-4 of the Office Action with a virtually identical analysis to that used in the previous Office Action. This analysis includes identifying in Postrel structures that correspond to the claimed first server (20), second server (10, 12 or 14), point offering means in the first server (col. 6, lines 47-50), and “point consuming means” (col. 6, lines 35-37) in the second server.

The Examiner also asserts that there is a “point transferring means” (col. 6, lines 20-27) for updating the point information stored in the second database in association with the user identifying information related to the user and the second server based on the point information stored in the first database in association with the user identifying information related to the user in the first server.

The Examiner states that “point consuming means” in the second server is a “means-plus-function” limitation that is considered an equivalent to the claimed means (page 18, lines 19-25) “as it performs the **same function** in substantially the same way and produces substantially the same result as the corresponding elements in Applicants’ specification.”

The Examiner admits that Postrel is silent on the **second server** providing the second service directly to a user, as it communicates with a central server. The Examiner looks to Martinez et al for a teaching that would support modification of Postrel.

Martinez et al

The newly cited reference to Martinez et al concerns a “virtual property system” in which vendors and consumers interact to purchase, sell, own and register rights to digital objects. The disclosed “transactor system,” as illustrated in Figs. 1 and 2, includes transactor servers 20, end users 30, brokers 40 and service providers 50. A transactor server defines the marketplace, provides transaction and ownership authentication, and is responsible for the objects and users defined in its own database. A group of transactor servers can have access to a common database. (col. 3, line 65-col. 4, line 31). A purchase transaction using a transactor server is described at col. 5, lines 58-col. 6, lines 36 with respect to Fig. 4. There are other transactions conducted by transactor servers, but most are based upon a “trust relationship” as described at col. 9, line 55-col. 10, line 11. The servers provide to transactor users a variety of server-side “services,” which are defined at col. 16, lines 1-11 as “services on a network, with no specific requirement that they be implemented as separate server processes on a particular machine or cluster of machines.”

The Examiner asserts that the server 20 that provides the services may comprise a plurality of servers, with reference to col. 3, lines 8-16. The Examiner concludes it would have

been obvious to one skilled in the art to utilize multiple servers to provide services directly to users as taught by Martinez.

Applicant respectfully disputes this conclusion, based on a careful examination of what is claimed and what is taught in Postrel and Martinez et al.

Distinctions over Cited Prior Art

No teaching of separate and independent servers for a common user

The key feature of the claimed invention is that a common user can go to separate and independent server/database facilities and (1) utilize the point generating services at an individual server/database facility such that the earned points are stored locally, and (2) access other server/databases where the same user may have earned and stored points and (a) transfer or (b) consume those previously stored points. The existence of separate servers is further emphasized by the amendment that specifies that the servers are separate and independent, and that the point transferring means directly transfers points stored in the first server to the second server.

Martinez et al, while noting that a single server can be replaced by plural servers, simply is teaching that the function of a given server can be distributed among plural servers. However, according to the definitions used in Martinez et al, the transactor server 20 is only responsible for the objects and users defined in its own database. Thus, Applicants respectfully submit that even if a given server is broken up into plural servers, it would have a common database and would provide a given user a service supported by the plural servers. The servers would be coordinated with respect to the same database and user, and would not be separate and independent. Each server would not be operative to have points earned locally and stored independently in separate databases for the same user.

No consideration of points storage and transfer between servers in Martinez

Even if the Examiner's assumption that Martinez et al teaches that a single server may be replaced by multiple servers, there is no teaching or suggestion that each of the multiple servers would have (1) user identifying information related to the user and (2) point information. Notably, both the first database and second database in the claimed invention requires that both

first server/first database and second server/second database has such information. Either Postrel, which has no teaching of multiple servers that provide services to users, or Martinez, which simply suggests replacing a single server with multiple servers, teaches or suggests that each server/database combination would have user identification information coupled with points information. At best, the combination of Postrel and Martinez teaches multiple servers that must coordinate through a common database. It would not be obvious to one skilled in the art, given the teachings of these two references, to provide the distribution of both user information and points data to individual locations, but rather to use a more efficient centralized system.

No point consuming means in Postrel or Martinez

In the previous Amendment, Applicants noted that a further limitation to a “second server” is the “point consuming means” that permits points to be consumed from a user’s account as a game is being played (page 20, lines 18-24). This service is provided directly to the user by the server that implements the game function. This is an autonomous function that is conducted without centralized control. The express function for this means as recited in amended claim 1 is “for updating the point information stored in the second database in association with the user identifying information related to the user so as to consume the points of the user **when the second points related service is provided to the user.**”

Postrel requires a reward server computer 10 to decrease a user’s reward points account 52 by a requested number of points in step 614 of Fig. 8 in response to a communication 110 from a reward server. Consumption of points is not a result of the provision of the second service, i.e., **when the second points related service is provided to the user**, as required by the claim.

Applicants respectfully submit that this significant difference has been ignored by the Examiner in the analysis. First, it is not taught in Postrel and certainly not taught in Martinez. The Examiner provides no comment with regard to this point at page 4 or in the Response to Arguments at page 18 of the Office Action. Second, the Examiner now admits that there is no “second server” in Postrel, yet continues to assert in his analysis at page 3 of the Office Action that the server 10, 12 or 14 has a “point consuming means.” This inconsistent position creates an inherent flaw in the rejection. Third, since there can be no second server and no point

consuming means in Postrel, there can be no structure that performs the same function in substantially the same way and produces substantially the same result, as required for anticipation under 35 U.S.C. § 112, sixth paragraph. Finally, even if the teachings of Martinez are used to split a server in Postrel into two, there is no teaching in either reference of the express function in the claim, namely “updating the point information stored in the second database in association with the user identifying information related to the user so as to consume the points of the user **when the second points related service is provided to the user.**”

In the absence of this critical element in either prior art reference, the rejection is overcome.

All Elements Rule Precludes Obviousness

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103, despite any recent revision to the Manual of Patent Examining Procedure (MPEP).

Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render claim 1 unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of the patents to Postrel and Martinez must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” See *In re Wada and Murphy*, Appeal 2007-3733, citing *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). Further, the necessary presence of all claim features is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added). Indeed, Applicant submits that this is why Section 904 of the MPEP instructs Examiners to conduct an art search that covers “the invention *as described and claimed*.”

(emphasis added). Lastly, Applicant respectfully directs attention to MPEP § 2143, the instructions of which buttress the conclusion that obviousness requires at least a suggestion of all of the features of a claim, since the Supreme Court in *KSR Int'l v. Teleflex Inc.* stated that “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (*quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In sum, it remains well-settled law that obviousness requires at least a suggestion of all of the features in a claim. See *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). It is clear that all elements of claim 1 are not taught in the cited art.

Claim 2

Claim 2 is patentable for the reasons given with respect to claim 1.

Claims 3-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Postrel in view of Martinez et al, as applied to claims 1 and 2, and further in view of Freishtat (6,567,850). This rejection is traversed for at least the following reasons.

The Examiner repeats identically the text of the rejection of claims 3 and 4 from the previous Office Action. Notably, the Examiner does not provide any additional comments with regard to claims 5 and 6.

As pointed out by the Applicants at page 12 of the previous Amendment, given the Examiner's admission that Postrel does not disclose a charge amount calculating means, and the Examiner's reliance on Freishtat for a teaching of a transaction model in which charges are calculated per transaction, without further assertion that the deficiencies of Postrel and Martinez are remedied by Freishtat, the rejection is overcome.

With regard to claims 5 and 6, the Examiner admits that Postrel, Martinez and Freishtat do not explicitly disclose the charge amount calculating means as described by the Applicants. The Examiner asserts that they are merely obvious design choices. Applicants would disagree.

Should the Examiner persist in this rejection, Applicants request that the Examiner identify prior art that shows “a charge amount calculating means that calculates an amount based

on the content stored in the first database,” as required by claim 5. Further, Applicants request the Examiner to identify prior art that teaches “a charge amount calculating means that calculates the amount based on the number of times access of predetermined type is made from the second server to the first server,” as required by claim 6.

Both of these relate to specific transactional features for calculating an amount of money to be paid from a person involved in the first server to a person involved in the second server. The simple assertion that one server may be the equivalent of plural servers does not teach or suggest the additional details of the operation between servers. These are important system and operational features that relate to the overall processes of the disclosed invention.

Failure to provide prior art at applicants’ request would create an inherent flaw in the rejection that would be reversed on appeal.

Claims 7-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Postrel in view of Martinez as applied to claims 1-2, and further in view of Atalla (4,268,715) and Durst, Jr. et al (2001/0032252). This rejection is traversed for at least the following reasons.

Claim 7

Claim 7 would be patentable for the reasons given with regard to parent claim 1. Neither Atalla nor Durst Jr. et al remedy the deficiencies of Postrel in view of Martinez et al, as already noted. Moreover, the detailed recitation of the point transferring means as comprising several additional limitations, which expressly require relationships between the first server and second server, and are stated as “means plus function” limitations, provides a further distinction of the combined teachings of the prior art. In particular, the prior art does not teach the identical function recited for each of the “secret information updating means,” the “point inquiry request receiving means,” the “point information and secret identification information returning means,” the point transfer request receiving means,” the “first point transferring means” and the “second point transferring means.”

First, all of these structures and their functions depend on the stated first and second servers, which are not taught by the prior art.

Second, the functions required by at least three means limitations are not in the prior art, including (1) for receiving a point inquiry request from the second server - there is no second server disclosed in Postrel or Martinez that performs this function; (2) for updating the point information stored in the first database to decrease a point balance and returning point transfer allowance data to the second server when the secret identification information included in the point transfer request received by the point transfer request receiving means matches the secret identification information stored in the first database - there is no second server disclosed in Postrel or Martinez that performs this function and the function itself is not taught or suggested, and (3) updating the point information stored in the second database to increase a point balance when the point transfer allowance data is returned from the first server by the first point transferring means - the function itself is not taught or suggested in Postrel or Martinez.

Claim 8

Applicants' analysis and argument with regard to claim 8 continue to apply and demonstrate that the claimed invention is patentable over Postrel, which is admitted to be deficient in failing to disclose "secret identification information updating means" and Atalla, which does not concern games specifically.

Moreover, the means plus function limitations in the claim are substantially the same as those in claim 7, and the remarks related to claim 7 (other than the presence of separate and independent servers) would apply.

Third, the claim requires a "secret identification information updating means" that updates the secret identification information when the point information stored in the first database is updated by the point information updating means. As noted, there is no updating each time verification of a user is established. Further, the claim expressly requires point information and secret identification information returning means for returning both the point information and secret identification information stored in the first database when a point inquiry request is received.

The Examiner looks to Durst for such teaching at paragraph 0134. In particular, the Examiner admits that Atalla and Postrel are silent on returning secret identification information

upon receiving a point inquiry request but asserts it is well known to have such information provided upon request.

However, Durst et al does not teach or suggest such feature where both point information and secret identification information are provided. Moreover, Durst et al does not remedy the deficiencies of Postrel, Martinez et al and Atalla.

Claims 9-11

With regard to these claims, Applicants' previous arguments continue to apply as Durst is insufficient to remedy those deficiencies.

Claim 12

This claim includes an express recitation of a first server and a second server, each coupled to a respective database and each having structure recited in "means plus function" language that would distinguish over the combination of prior art for the reasons given. In particular, the function of each means, as literally recited, is not taught in any reference, taken alone or in combination.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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